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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,353	08/14/2001	Naoya Suzuki	212667US6	6434
22850	7590	12/15/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WALSH, JOHN B	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/928,353	Applicant(s) SUZUKI, NAOYA	
	Examiner John B. Walsh	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE of 10/14/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,13,15,16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,13,15,16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/14/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The information disclosure statement filed August 11, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a translation of reference AW has not been provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,216,158 to Luo et al.

As concerns claim 18, a wireless telephone configured to perform communication via a wireless telephone network (column 5, lines 57-65), said wireless telephone having wireless communication means for performing wireless communication with an information processing device (column 5, lines 57-65), operation means for entering a command for displaying a menu

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item of said remote controller terminal, and for entering a command for requiring a function item of said information processing device and for selecting the function item from among a plurality of function items (input capabilities, column 1, lines 24-25), and control means for controlling said wireless communication means to send a first command for requiring said function item and sending a command for requiring further information of said function item according to operation of said operation means (inherent that Palm has a receiver/transmitter and CPU which may act as control means).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 13 and 21 (as applied to claim 18 above) are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,216,158 to Luo et al. in view of U.S. Patent No. 5,729,220 to Russell.

Luo et al. disclose an information processing system comprising a remote controller terminal (palm sized computer, 100) and an information processing device (110, 120, 130, 140, 150, column 1, lines 18-19), said information processing system wherein: said remote controller terminal includes: a wireless telephone mechanism configured to communicate via a wireless telephone network (column 5, lines 57-65); first wireless communication means for performing wireless communication with said information processing device (column 5, lines 57-65);

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operation means for entering a command for displaying at least menu items of said remote controller terminal, and for entering a command for requiring a function item of said information processing device and for selecting the function item from among said function items (input capabilities, column 1, lines 24-25); first control means for controlling said wireless communication means to send a first command for requiring said function item and sending a second command for requiring further information of said function item according to operation of said operation means (inherent that Palm has a receiver/transmitter and CPU which may act as control means); and display means for displaying said menu items, said function item and said further information (figure 1, palm 100 has a screen for displaying); said information processing device (110, 120, 130, 140, 150, column 1, lines 18-19) includes: second wireless communication means for performing wireless communication with said remote controller terminal (column 5, lines 57-65, info processing device has transmitter/receiver which communicates with the Palm via the selected mode of communication, i.e. wireless); and second control means (inherent that information processing device has a CPU for controlling, column 1, lines 18-19) for controlling said second wireless communication means to send the function item and further information to said remote controller terminal according to said first command and said second command transmitted from said remote controller terminal.

As concerns claim 13, a wireless telephone mechanism configured to communicate via a wireless telephone network (column 5, lines 57-65); wireless communication means for performing wireless communication with said information processing device (column 5, lines 57-65); operation means for entering a command for displaying at least menu items of said remote controller terminal, and for entering a command for requiring a function item of said

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information processing device and for selecting the function item from among said function items (input capabilities, column 1, lines 24-25); control means for controlling said wireless communication means to send a first command for requiring said function item and sending a second command for requiring further information of said function item according to operation of said operation means (inherent that Palm has a receiver/transmitter and CPU which may act as control means).

Luo et al. '158 do not explicitly disclose a first and second authentication ID.

Russell '220 teaches a first authentication ID to said remote controller terminal and the second control means determines that said first authentication ID is identical to a second authentication ID stored in said information processing device (figure 13A; column 14, lines 50-65; column 15, lines 20-28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Luo et al. '158 with authentication ID's in order to provide for secure transmissions of data and access.

6. Claims 3, 4, 15, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,216,158 to Luo et al. and U.S. Patent No. 5,729,220 to Russell as applied to claims 1 and 13 above in view of EP 0 797 336 A2.

As concerns claims 3, 15 and 19, wherein said operation means is a jog dial for selecting the function item out of the plurality of said function items by rotation operation and fixing a selection of function item by a pushing operation.

Luo et al. '158 as modified do not explicitly disclose a jog dial.

EP '336 teaches a jog dial (61).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the palm of Luo et al. '158 as modified with a jog dial, as taught by EP '336, in order to provide a means of selecting a desired function with one hand which also is used to hold the palm as well.

As concerns claims 4, 16 and 20, wherein said display means of said remote controller terminal scroll-displays the plurality of function item names in accordance with the rotation operation of said operation means by the user, and also remarkably displays a desired function item name being selected (inherent that a jog dial will scroll through a display of functions when rotated).

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

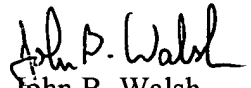
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Wednesday from 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John B. Walsh
Primary Examiner
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